

DOCKET NO: 285333US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF	:
MICHEL STREBELLE	: EXAMINER: MICALI, JOSEPH
SERIAL NO: 10/567,263	:
FILED: FEBRUARY 6, 2006	: GROUP ART UNIT: 1793
FOR: PROCESS FOR REGENERATING A HYDROGENATION CATALYST	:

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

The following is a REPLY to the Examiner's Answer Dated April 28,
2010. Oral Hearing is requested.

REPLY

The greater weight of the evidence herein supports the finding that, prior to the present invention, those of ordinary skill in the art, including the authors of Volheim, considered Volheim's catalyst to be non-regenerable.

DE 24 38 153 (i.e., Volheim, cited against the pending claims) broadly states that regeneration of the spent catalyst described therein is "economically worthwhile," "technically light" and "possible." No details or suggestions are given in Volheim regarding *how* to regenerate the spent catalyst.

The *article* by Volheim, of record herein and described in Appellants' original specification at page 1, lines 21-25, published more than a decade after the Volheim patent, paints a very different story. As explained in Appellants' original specification, the Volheim article shows that "in practice such regeneration [of the Volheim catalyst] has proved to be fruitless, owing in particular to the contamination of this catalyst with heavy metals." (emphasis added).

This admission, coming more than a decade after the Volheim patent, has been dismissed by the Examiner, who incorrectly alleges that "applicant does not make a point as to what the article discloses" and "applicant does nothing with the cited [article]."¹ To the contrary, Appellants specifically point out what the Volheim article discloses in their original specification, and use this to expose the speculative statements concerning catalyst regeneration in the

¹ See the sentence bridging pages 6-7 and page 7, line 2 of the Examiner's Answer.

Volheim patent for what they are - wishful thinking: “although the [Volheim patent] records the possibility in theory of regenerating [the spent catalyst], in practice such regeneration has proved to be fruitless, owing in particular to the contamination of this catalyst with heavy metals.” (emphasis added).

There is more. Appellant, in attempting to actually carry out Volheim’s supposedly “economically worthwhile,” “technically light” and “possible” regeneration of his spent hydrogenation catalyst turned to Volheim’s employer for direction. In response, Appellant received a letter from the supplier, of record herein, informing them, consistent with the Volheim article, that “no catalyst regeneration [is] possible,” and recommending instead replacement with fresh catalyst.

Clearly, the greater weight of the evidence herein supports the finding that those of ordinary skill in the art considered Volheim’s catalyst to be non-regenerable. In accordance, the finding that the regeneration of the particularly claimed spent hydrogenation catalysts herein can be accomplished by thermal treatment in the presence of oxygen at a temperature of between 300 and 700 °C is described as “completely surprising” in the Declaration of Michel Strebelle, (para. 6).

Unquestionably, Volheim is insufficient, on its own, to present a *prima facie* case against the pending claims. In addition, Appellants have shown that those of ordinary skill in the art considered Volheim’s catalyst to be non-regenerable. Welty, cited to make up for that lacking in Volheim, does not

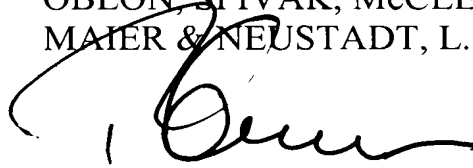
suggest that Volheim's catalysts can be regenerated, but rather discloses the regeneration of different catalysts used for different things. The Examiner exposes his reason for combining Welty with Volheim at page 8, line 4 of the Examiner's Answer: "...most importantly, [Welty] discloses the instant method for catalyst regeneration."

Appellants are not claiming the regeneration of any catalyst by thermal treatment in the presence of oxygen at a temperature of between 300 and 700 °C, but rather are claiming the regeneration of a catalyst established to have been previously considered to be non-regenerable by those of ordinary skill in the art. Welty does nothing to change the understanding in the art that the catalysts being regenerated herein were previously considered to be non-regenerable. The fact is that Welty was published in 1940. Welty thus clearly existed at the time of both the Volheim patent and the Volheim article, yet those of ordinary skill still considered the Volheim catalyst to be non-regenerable. Thus, and clearly, the fact that Welty discloses that thermal treatment has been used to regenerate other types of spent catalysts does not negate patentability herein, or lessen the importance of Appellant's objective evidence of the failure of others.

For these reasons the rejection under 35 U.S.C. 103(a) over Volheim in view of Welty is in error and should be REVERSED.

Respectfully submitted,

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